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Mailed: September 7, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BCPBank National Association

Serial No. 76513504

Virginia R. Richard of Winston & Strawn for BCPBank National Association.

Kathleen M. Vanston, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Walters, Chapman and Drost, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

On May 12, 2003, BCPBank National Association filed an application to register the mark BEYOND THE EXPECTED on the Principal Register based on an allegation of a bona fide intention to use the mark in commerce in connection with "banking services" in International Class 36. Registration of the proposed mark is sought in standard character form.¹

¹ Applicant submitted an amendment to allege use, alleging first use and use in commerce as of May 19, 2003, with specimens. The amendment and specimen were accepted by the examining attorney.

The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the registered mark BANKING BEYOND YOUR EXPECTATIONS, in standard character format, for the services set forth below, that, if used on or in connection with applicant's services, it would be likely to cause confusion or mistake or to deceive.

"Banking services; providing banking and securities underwriting and brokerage services; mutual fund administration and brokerage services; home, accident, fire, and life insurance underwriting and brokerage services; commercial banking services, namely, offering financing in the form of equity investments; bond administration; investment advisory services; financial planning services; financial management services; fund investment services; investment brokerage services; and providing information in the field of banking, finance, and insurance, through electronic means" in International Class 36.²

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

The examining attorney contends that the services are identical and the marks are confusingly similar. She argues that because BANKING is merely descriptive and disclaimed in the registered mark, the dominant portion of that mark is BEYOND YOUR EXPECTATIONS; that BEYOND is common to both

marks; and that EXPECTED and EXPECTATIONS, as well as BEYOND THE EXPECTED and BEYOND YOUR EXPECTATIONS, create similar commercial impressions.

Applicant contends that the marks create different commercial impressions and the examining attorney has improperly dissected the marks; that "consumers of banking services are sophisticated due to the high degree of care exercised by consumers in choosing an entity to handle their money" (brief, p. 3); that there are a number of similar third-party marks in the financial services field that use the term EXPECT or EXPECTATION; and that there has been no actual confusion despite almost two years of contemporaneous use. Applicant submitted copies of seven third-party registrations each owned by a different entity, all for banking services, for the following marks: NORTH OF EXPECTED; RAISE YOUR EXPECTATIONS; UNEXPECTEDLY MORE; MORE THAN YOU'D EXPECT FROM A BANK; EXPECT MORE FROM US; EXPECT THE BEST; and EXPECT.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re*

² Registration No. 2756040 issued August 26, 2003, to Manufacturers and Traders Trust Company. The registration includes a disclaimer of the word BANKING apart from the mark as a whole.

Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The factors deemed pertinent in this proceeding are discussed below.

We turn, first, to the second and third *du Pont* factors, i.e., the similarity or dissimilarity of the respective services, and the similarity or dissimilarity of the trade channels and classes of purchasers of these services. We must make our determinations under these factors based on the services as they are recited in the application and registration, respectively. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Applicant's "banking services" are identical to the "banking services" recited in the cited registration. As such, we much conclude that the trade channels and class of purchasers are identical. In this regard, we are not persuaded that, as applicant contends, the purchasers of banking services are

sophisticated persons and entities who choose such services with care. There is no evidence in the record on this factor and we must presume that the class of purchasers for banking services is all purchasers of such services, including the general public, and that all levels of sophistication would be represented therein.

Turning to the first *du Pont* factor, the similarity or dissimilarity of the respective marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

It is with respect to the marks that we disagree with the examining attorney's analysis. We agree that BANKING is a descriptive term in connection with the involved services; however, we find that the mark in the cited registration is a unitary phrase, BANKING BEYOND YOUR EXPECTATIONS, and that the examining attorney dissected the mark by essentially deleting the term BANKING from the mark when considering the phrase. Further, while both marks include the term BEYOND,

we find that the connotations of BEYOND THE EXPECTED and BEYOND YOUR EXPECTATIONS to be different. In the context of the services, BEYOND THE EXPECTED is likely to be perceived as suggesting that the banking services are better than those offered by other banks; whereas BANKING BEYOND YOUR EXPECTATIONS is likely to be perceived as suggesting that the purchaser's individual banking experience will be beyond his or her personal expectation for such services. The connotations of both marks have a certain laudatory character. This same laudatory character is similarly present in the third-party registered marks of record, for the identical services, that all contain the root word EXPECT and suggest superior banking services.

Moreover, as the third-party registrations suggest, the cited registration appears to be a relatively weak laudatory mark. Thus, we conclude, on this ex parte record, that applicant's mark is sufficiently distinct from the cited registered mark that confusion as to source is unlikely.³

Decision: The refusal under Section 2(d) of the Trademark Act is reversed.

³ We have given little consideration to applicant's assertion that it is aware of no instances of actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant. While a factor to be considered, the absence or presence of actual confusion is of limited probative value where we have scant, if any, evidence pertaining to the nature and extent of the use by applicant and the cited registrant. Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See, *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992).